

**REMARKS**

Claims 1-26 are all of the claims presently pending in the application. Claims 27-31 have been canceled without prejudice or disclaimer. Claims 1, 2, 7 and 13 have been merely editorially amended to more particularly define the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-26 stand rejected under 35 U.S.C. 101. Claims 1-26 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1-11, 13-15, 17, 19 and 22-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kamata et al. (U.S. Patent Application No. 6,814,224) (hereinafter "Kamata"). Claims 1-3, 11-14 and 19-26 stand rejected under 35 U.S.C. 102(e) as being anticipated by Grynkewich et al. (U.S. Patent No. 6,881,351) (hereinafter "Grynkewich"). Claims 12, 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata in view of Grynkewich. Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata or Grynkewich in view of Klemmer et al. (U.S. Patent No. 6,849, 349) (hereinafter "Klemmer"). Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata.

These rejections are respectfully traversed in the following discussion.

**I. THE 35 U.S.C. § 101 REJECTION**

Claims 1-26 stand rejected under 35 U.S.C. 101 for reciting a use without setting forth any steps involved in the process.

Applicants have amended the claims to specifically set forth steps in the claimed process. Specifically, Applicants have amended claim 1 to recite, inter alia, “transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical transformation”.

In view of the foregoing amendments to the claims, Applicants respectfully request the Examiner to reconsider and withdraw the present rejection.

**II. THE 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION**

Claims 1-26 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants have amended the claims to more clearly define the claimed invention.

That is, regarding claims 1 and 2, Applicants have amended the claims to specifically set forth the steps involved in the claimed method.

Regarding claim 7, Applicants have replaced the trademark “Permalloy” with the chemical composition of Permalloy,  $\text{Ni}_{0.8}\text{Fe}_{0.2}$ .

Claim 13 has been amended to recite “producing a magnetic device”. The term “functioning” has been deleted from claim 13. Applicants respectfully submit, however, that the term “producing” is not indefinite as alleged by the Examiner. Claim 13 clearly recites a specific step of producing a magnetic device. While the term “producing” may

be broad, it is not indefinite. A person reasonably skilled in the art would clearly understand what is meant by the phrase “producing a magnetic device”.

Therefore, in view of the above amendments and arguments, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

### **III. THE PRIOR ART BASED REJECTIONS**

#### **A. The Kamata Reference**

Claims 1-11, 13-15, 17, 19 and 22-26 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kamata. Additionally, claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata.

Applicants respectfully submit, however, that Kamata can be removed by swearing behind the filing date of the Kamata reference.

The Kamata reference was filed on March 29, 2002 and issued as a U.S. Patent on January 11, 2005. Thus, the earliest effective prior date of the Kamata reference is March 29, 2002, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to March 29, 2002. Therefore, the Kamata reference is removed by the concurrent filing of a Declaration under 37 C.F.R. 1.131.

Accompanying this Amendment is a Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor’s Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showing invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Kamata reference.

Thus, Kamata is removed as a prior art reference and the Examiner's rejections based on Kamata should be withdrawn.

**B. The Grynkewich Reference**

Claims 1-3, 11-14 and 19-26 stand rejected under 35 U.S.C. 102(e) as being anticipated by Grynkewich. Additionally, claims 12, 20 and 21 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Kamata in view of Grynkewich.

Applicants respectfully submit, however, that Grynkewich can be removed by swearing behind the filing date of the Grynkewich reference.

The Grynkewich reference was filed on April 22, 2003 and issued as a U.S. Patent April 19, 2005. Thus, the earliest effective prior date of the Grynkewich reference is April 22, 2003, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to April 22, 2003. Therefore, the Grynkewich reference is removed by the concurrent filing of a Declaration under 37 C.F.R. 1.131.

Accompanying this Amendment is a Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor's Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showing invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Grynkewich reference.

Thus, Grynkewich is removed as a prior art reference and the Examiner's rejections based on Grynkewich should be withdrawn.

### **C. The Klemmer Reference**

Claims 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kamata in view of Grynkewich and further in view of Klemmer.

As indicated above, the Kamata and Grynkewich references are removed as prior art references.

Additionally, Klemmer can be removed by swearing behind the filing date of the Klemmer reference.

The Klemmer reference was filed on October 21, 2002 and issued as a U.S. Patent February 1, 2005. Thus, the earliest effective prior date of the Klemmer reference is October 21, 2002, its U.S. filing date. Applicants submit that the claimed invention was invented and reduced to practice prior to October 21, 2002. Therefore, the Klemmer reference is removed by the concurrent filing of a Declaration under 37 C.F.R. 1.131.

Accompanying this Amendment is a Declaration under 37 C.F.R. 1.131 (and Exhibit 1 – The Inventor's Original Write-Up of the Invention, Exhibit 2- The Original IBM Internal Disclosure Document, and Exhibit 3 – The MDA Invention Review Board Disclosure) showing invention and actual reduction to practice of the subject matter of the present application prior to the filing date of the Klemmer reference.

Thus, Klemmer is removed as a prior art reference and the Examiner's rejections based on Klemmer should be withdrawn.

### **IV. FORMAL MATTERS AND CONCLUSION**

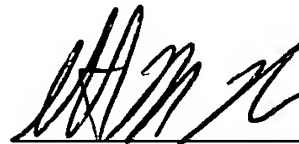
In accordance with the Examiner's objection to the Specification, the Title of the Invention has been amended above in accordance with the Examiner's recommendations.

In view of the foregoing, Applicants submit that claims 1-26, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview. The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

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